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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,242	07/15/2003	Tai H. Nguyen	Nbuyt03/03RI	8397

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MADISONVILLE, LA 70447-0429

EXAMINER

FOSTER, JIMMY G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,242

Applicant(s)

NGUYEN, TAI H. 

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1) The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

2) Claims 5-10 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

More specifically, the present claims 5-10 are attempting to remove a limitation which had been effectively added to the claims 14-17 of the parent application (which became claims 1-4 of the patent) relative to the canceled claims 1, 9 and 11 of the parent application in order to achieve allowance of said claims 14-17. The limitation effectively added to said claims 14-17 and not found in claims 1, 9 and 11 is the limitation, "said first and second linear cut sections penetrating said handles."

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3) Claims 9 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear, because of the comma between the words "second" and "cut" what is being claimed by the limitation, "first and second, cut sections" in each of claims 9 and 10. More specifically it is not clear whether the words "first" and "second" are intended to modify the word "sections".

Additionally, in claim 10, the limitation, engages said first and second punch stamps the front wall of the next bag" makes not idiomatic sense. It is unclear what Applicant is attempting to cover by this limitation.

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5) Claims 1 and 5-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Boyd (5,333,730). In the reference of Boyd, there is provided

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a bag pack 10 including a plurality of stacked, aligned bags (see Fig. 6). Each bag has a mouth opening 20 including a raised medial area/suspension tab 22 and has handles 12 on each side of the bag, emanating from the bag mouth. The handles include a top end at the upper extent thereof. The handles also include a bottom end at a connection with the main body of the bag, from where the handles form an extension of the front, rear and side walls of the bag. The handles respectively include an inner side edge facing toward the raised medial portion of said mouth. The handles include a medial area between the upper and lower ends.

Within the tab/mouth-medial area 22 is a first cut 26 which may be used as a support cut (see Fig. 6). Also within the mouth medial area is additional cuts/perforations 48 (see col. 2, lines 45-48). Any one of the cuts 48 may be considered to define a dispensing cut that is spaced from the cut 26. Regarding Applicant's limitation calling for the dispense cut to be spaced in a lateral fashion from the support cut, this is broad enough to mean that the dispense cut is not in alignment with the longitudinal axis of the support cut. Accordingly, the dispense cuts 48 of Boyd meet this limitation.

The handles of the bags of Boyd include orifices 44 in the medial area of the handle. The orifices 44, when not on the rack, are linear. Because the line of each orifice can inherently be considered to have multiple aligned linear sections connected end-on-end, Applicant's limitation calling for first and second linear sections does not distinguish Applicant's punch cuts over the orifice of Boyd.

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Additionally, the reference of Boyd describes the handles (12) as being defined by a cutting mechanism (see col. 3, line 68 through col. 4, line 2). Furthermore, there is an alignment of the orifices of the bags of the pack (see col. 3, lines 44-45). It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Even if, somehow, the disclosure of Boyd of defining the handles by a cutting mechanism is not a disclosure that the orifices are cut by the cutting mechanism and even if this is clearly not a disclosure that the orifices are cut by punch stamps, the structure of the punch cuts of the product claimed by Applicant is met by the structure of the orifices 44 of Boyd since the orifices 44 of Boyd are linear.

6) Claims 5-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Huang et al (5,938,033). In the reference of Huang et al, there is provided a bag pack 110 including a plurality of stacked, aligned bags (see Fig. 6). Each bag has a mouth opening (see Figure 13, col. 10, lines 8-10) including a raised medial area/tab portion 118,118 and has handles (unnumbered but similar to handles 16) on each side of the bag, emanating from the bag mouth. The handles include a top end at the upper extent thereof. The handles also include a bottom end at a connection with the main body of the bag, from where the handles form an extension from the lower body portion (unnumbered but similar to lower body portion 14) of the bag. The handles respectively include an inner side edge facing toward the raised

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medial portion of said mouth. The handles include a medial area between the upper and lower ends.

Within the tab portion/mouth-medial area 118, 118 is a first cut (one of the mouth tab slits 112) which may be used as a support cut (in the manner of mouth hole 34 of another embodiment). Also within the mouth medial area is an additional cut/mouth tab slit 112. The second slit may be considered to define a dispensing cut that is spaced from the support cut. Inasmuch as the bags of Figure 6 are dispensed in similar fashion to the bags of the other embodiments, the second slit may be considered to define a dispense cut. Regarding Applicant's limitation calling for the dispense cut to be spaced in a lateral fashion from the support cut, this is broad enough to mean that the dispense cut is not in alignment with the longitudinal axis of the support cut. Accordingly, the dispense cut (the second of slits 112) of Huang et al meets this limitation.

The handles of the bags of Huang et al include handle slits 114 in the medial area of the handle. The slits 114, when not on the rack, are linear. Because the line of each slit 114 can inherently be considered to have multiple aligned linear sections connected end-on-end, Applicant's limitation calling for first and second linear sections does not distinguish Applicant's punch cuts over the slits 114 of Huang et al.

Additionally, the reference of Huang et al describes the handle slits 114 as being formed by a punch/die member 122. Accordingly, the slits 114 are punch cuts. Moreover, the punch/die member includes a flat leading edge 130 as well as a blade portion 124; so that when the slits 114 are made, the adjacent cold frangible bonds 116 are also made. This defines a composite

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linear punch cut which will bond the bags together while cutting through the bags. The examiner asserts that this will result in a bag pack as claimed by Applicant, wherein when the lead bag is removed from the pack, the rear wall of the lead bag will engage at the first and second composite slits/punch cuts 114,116 with the front wall of the following bag for transferring pulling force to the following bag through the punch cuts, tending to pull the following bag into an open position as the lead bag is removed from the bag pack by the user (again see Figure 13, col. 10, lines 8-10).

It is noted that inasmuch as the patent claim 1 limitation calling for the support cut to be horizontally situated is interpreted by the examiner as being horizontally oriented (when the handles have upper and lower ends), the support cut 112 of Huang et al, as herein described, is not considered to meet the support cut of patent claim 1.

7) The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 1 and 5-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd et al (5,183,158) in view of Beasley et al (5,335,788). In the reference of Boyd et al, there is provided a bag pack 10 including an aligned stack of bags. Each bag includes an open mouth 14,

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handles 12, a raised medial region/tab 22, dispensing cuts/perforations 26, and handle cuts/slits 18.

The handle cuts 18, when not on the rack, are linear since they are characterized as slits. Because the line of each orifice can inherently be considered to have multiple aligned linear sections connected end-on-end, Applicant's limitation calling for first and second linear sections does not distinguish Applicant's punch cuts over the slits 18 of Boyd et al.

Furthermore, there is an alignment of the orifices of the bags of the pack (see col. 3, lines 35-37). It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Even if the slits are not cut by punch stamps, the structure of the punch cuts of the product claimed by Applicant is met by the structure of the slits 18 of Boyd since the slits of Boyd et al are linear.

Although the suspension/supporting opening 24 of Boyd et al may not be a cut, the reference of Beasley et al, at slit or aperture 22, suggests that a suspension opening (22) may be made as a cut from a die including a cutting member (130). As indicated in Figure 7 of Beasley et al, this efficiently permits the mouth and all of the openings to be made at once though a stack of bags. Accordingly, it would have been obvious in view of Beasley et al to have made the opening 24 of Boyd et al as a cut by a cutting die, for efficiently forming the handle and the openings in the stack of bags at the same time.

9) The nonstatutory double patenting rejections below are based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10) Claims 6-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,561,967. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent claim 5 includes all of the subject matter set forth in each of the present claims 6-10, or because the subject matter of the present claims different than that of the patent claims would have been obvious. More specifically, patent claim 5 calls for a plurality of stacked bags, a bag mouth having opposing ends and a medial area for each bag, first and second handles emanating from the bag mouth for each bag, and first and second punch stamps for each bags. In addition, the punch stamps are claimed as being releasable binding means for the bags to one another, which reads on the limitation in the present claims which calls for the punch stamps to releasably retain the bags in a stacked configuration. Also, claim 5 calls for a tab emanating from the mouth, which will give the mouth a lower edge (see present claim 6).

Also, patent claim 5 calls for the punch stamps to be made by punches having linear punch members. The examiner asserts that this would inherently provide the punch stamps with first and second linear cut sections.

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In addition it is well known to align bags in a stack. It is apparent that this forms an orderly combination. Accordingly, it would have been obvious in view of this to have made the bags of patent claim 5 aligned.

11) Claims 6-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 5,863,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent claim 14 includes all of the subject matter set forth in each of the present claims 6-10, or because the subject matter of the present claims different than that of the patent claims would have been obvious. More specifically, the patent claim 14 calls for a plurality of stacked bags, a bag mouth having opposing ends and a medial area for each bag, first and second handles emanating from the bag mouth for each bag, and first and second punch stamps for each bags. In addition, the punch stamps are claimed as being releasable binding means for the bags to one another, which reads on the limitation in the present claims which calls for the punch stamps to releasably retain the bags in a stacked configuration. Also, claim 14 calls for a tab emanating from the mouth, which will give the mouth a lower edge (see present claim 6).

Also, patent claim 5 calls for the punch stamps to be made by punches having linear punch members. The examiner asserts that this would inherently provide the punch stamps with first and second linear cut sections. In addition it is well known to align bags in a stack. It is apparent that this forms an orderly combination. Accordingly, it would have been obvious in view of this to have made the bags of patent claim 5 aligned.

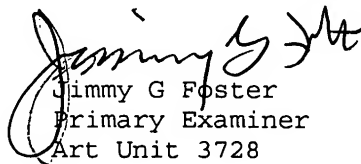
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12) Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
25 October 2004